

REMARKS/ARGUMENTS

This application has been carefully considered in light of the Initial Office Action on the merits mailed October 15, 2004. In the Initial Office Action the Examiner has reiterated that claims 8, 9 and 13 are withdrawn from further consideration as no generic claim had been allowed. In the light of the amendment to the claims submitted herewith, it is respectfully submitted that at least claim 1 should be in condition for allowance. Therefore, reconsideration of the withdrawal with respect to claims 8, 9 and 13 is respectfully requested as these claims depend directly or indirectly from claim 1 and therefore should be considered on the merits as depending from an allowable generic claim. Therefore, consideration of these claims on the merits is specifically requested.

Claims 1-7, 10-12 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. In this respect, claim 1 has been amended to positively recite the opposite sides of the surfaces involved and therefore it is believed that this grounds of rejection has been overcome. Further, claim 4 has also been amended to remove the phrase objected to by the Examiner.

Claims 1-7, 10 and 11 have been rejected under 35 U.S.C. § 102(e) as being directly anticipated by US Patent 6,749,637 to

Bahler. In view of the comments set forth below reconsideration of this grounds for rejection is solicited.

The Examiner has indicated that claim 12 is only objected to as being dependent upon a rejected base claim but would be allowed if rewritten in independent form to include the limitations of the base claim and any intervening claims.

The reference to Bahler discloses a shoulder prosthesis where an articulation surface 75 of a cap 65 does cooperate with a natural joint phase of the glenoid or with an implemented glenoid part 85. The surface 75 and the natural or artificial glenoid surface do constitute a first set of articulation surfaces which are slidably movable relative to one another. However, the convex/concave surfaces 43 and 35 referenced by the Examiner are not believed to be articulation surfaces allowing sliding movement relative to one another. Rather, these surfaces are used to set the orientation of the cap 65 with respect to a shaft 11 of the prosthesis before a directional piece 41 is fixed within the rotating piece 33 as set forth in the second paragraph of column 9 of the reference.

In Bahler, once the prosthesis is assembled, there is no sliding of the surfaces 43 and 35 relative to one another so that there can be no instantaneous center of rotation similar to C₁ identified in the present application for patent. Further, there

can be no locus similar to A₁ of the present invention which would be located on an opposite surface with respect to a second locus A₂.

Therefore, the reference does not disclose any surface similar to S'₁ in the reference to Bahler since the convex surface 43 is not an articulation surface which allows relative sliding of the prosthesis during normal use.

The present invention provides a prosthesis wherein two sets of opposing surfaces slide relative to one another as set forth in claim 1 as amended. As no similar surfaces appear in the reference to Bahler, reconsideration of the grounds for rejection and favorable consideration and allowance of claim 1 is respectfully requested.

It is further believed that the remaining claims which depend from claim 1 should now also be in condition for allowance which action is requested.

Should the Examiner have any questions regarding the allowability of the claims or any questions concerning the amendments to the claims, it is respectfully requested that the Examiner contact the undersigned attorney-of-record at the telephone number shown below for further expediting the prosecution of this application.

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Respectfully submitted,

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By

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